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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/614,790	07/12/2000	Sharon F. Kleyne	HME/7982.001	2570

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HOWARD EISENBERG, ESQ.
2206 APPLEWOOD COURT
PERKASIE, PA 18944

EXAMINER	
WANG, SHENGJUN	
ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/614,790	KLEYNE, SHARON F.	
	Examiner	Art Unit	
	Shengjun Wang	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 April 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *90-97* is/are pending in the application.

4a) Of the above claim(s) *94-96* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *90-93,97* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 15, 2005 has been entered.

Claim Rejections 35 U.S.C. 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 90-93, and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Junkel et al. (US 5,620,633), in view of Hahn et al. (US 5,893,515, IDS), Hutson et al. (US 5,588,564, IDS), in further view of Embleton (of record).

Junkel et al. teaches a potable misting device for sunbathers and others involved in athletic pursuits, which provide a cooling current air with atomized liquid mist, such as water, to combat the elements of heat and dehydration attendant with athletic activities and/or prolonged exposure to the sun. Junkel et al. further disclosed that such type of devices is well-known in the art. See, particularly, the abstract, and column 1, lines 18-63. The device comprises a sealed container, water within the container, and an actuator for spraying a mist of water from the container, See, particularly, the drawing, and columns 4, line 60 bridging to column 5, line 10.

Junkel et al. do not teach expressly to apply the mist to the face of a subject, or the subject is suffering from dry eye.

However, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to direct the fan-mist device to the face, and apply the mist accordingly and enjoy the relief of the dryness, including the dry eye condition, caused by heat and dehydration. Further, it would have been obvious to any one who experienced dry condition, and suffering dry eye to apply a mist to moisturizing the eye and relieve the dryness, particularly, in view the fact that device for producing water mist is common and is with access of normal person. See, e.g., Hahn et al. and Hutson et al. It is a basic instinct for human to use water for relieve of dryness. Any form of water, including mist would have been obvious to a person experiencing dryness. As to claim 92, which recites the particular condition of protein and electrolytes, it is noted the mist generated by the device of Junkel is not likely to wash away those protein and electrolyte since the water is in the form of mist, not a stream. Further, the employment of pressurizing agent in a mist generating device instead of hand generated pressure as disclosed by Junkel et al. is seen to be an obvious variation and is within the skill of artisan. Further, Embleton teaches that liquid administered to the eyes should be not more than 30 μl, over administering of liquid to eyes provide no benefit. (see page 1, lines 5-23). Therefore, one would not try to over flow the eye with excess of water. Further, note the size of droplets in mist is in the range of 2 to 100 micrometers. See "Selected terms in colloid and interface science Aerosols." (of record). Note as to the "dry eye," recited in the claims, absent specific definition in the claims or in the specification, the term is given a broad interpretation. As to the limitation "and wherein the water is sprayed on the surface of eye within

a period of 10 seconds (or 5 seconds)," note it would have been obvious to moisturize the eyes with just one or two bolus of the mist as that should have been sufficient to relieve the dryness, particularly, in view of Embleton's teaching that liquid administered to the eyes should be not more than 30 µl, over administering of liquid to eyes provide no benefit.

Response to the Arguments

Applicants' amendments and remarks, along with the declaration by Dr. Mathers have been fully considered, but are found unpersuasive as to the rejections set forth above.

4. Applicants argue that Junkel in not pertinent to the present invention. The arguments are not convincing. The claimed invention is directed to apply mist to the eyes of a person experiencing dryness. Junkel et al. teach a way to relieve dryness by applying a mist. Junkel's reference is deemed relevant. In response to applicant's argument that there is no teaching or suggestion in the cited reference to arrive the claimed invention, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching, suggestion and motivation are found both in the prior art, and in the knowledge generally available to one of ordinary skill in the art. Particularly, one would have been motivated to apply a mist to his or her eyes if he or she experiences dry eye.

The declaration under 37 CFR 1.132 filed April 15, 2005, as well as those filed earlier, is insufficient to overcome the rejection of claims 90-93 based upon Junkel et al as set forth above because: the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). It is well settled patent law that mode of action elucidation does not impart patentable moment to otherwise old and obvious subject matter. Applicant's attention is directed to In re Swinehart, (169 USPQ 226 at 229) where the Court of Customs and Patent Appeals stated "is elementary that the mere recitation of a newly discovered function or property, inherently possessed by thing in the prior art, does not cause a claim drawn to those things to distinguish over the prior art." In the instant invention, the claims are directed to the ultimate utility set forth in the prior art, albeit distanced by various functions. The ultimate utility for the claimed compound (water) is old and well known rendering the claimed subject matter obvious to the skilled artisan. It would follow therefore that the instant claims are properly rejected under 35 USC 103.

Applicants further argued that the objective evidences presented in the declaration should have been sufficient to rebut the prima facie case of obviousness. The arguments are not convincing. As discussed above, moisturizing eye with plain water is obvious as it arise from a common sense. Applicants' discovery that this old, or otherwise obvious practice, is better than a commercial method, i.e., artificial tear, is by no mean to be sufficient to make this method patentable. It is deemed improper to exclude others from practice this old, and/or otherwise obvious method.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SHENGJUN WANG
PRIMARY EXAMINER

Shengjun Wang
Primary Examiner
Art Unit 1617